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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 1285

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on 10/19/2010

Signature /Jamie Cameron/

Typed or printed name Jamie Cameron

Application Number	Filed
09/498,515	02/04/2000

First Named Inventor: Howard G. Page

Art Unit	Examiner
3622	Yehdega Retta

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 55,827.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Todd C. Adelmann/
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10/19/2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

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Practitioner's Docket No. 1285 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Howard G. Page	Confirmation No.: 8911
Application No.: 09/498,515	Group No.: 3622
Filed: 02/04/2000	Examiner: Yehdega Retta

For: ADVERTISING INSERTION FOR A VIDEO-ON-DEMAND SYSTEM

Mailstop: AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated July 19, 2010, and the Advisory Action dated September 29, 2010, Applicant requests review of the final rejection in the above identified application. No amendments are being filed with this request. A Notice of Appeal under 37 CFR § 41.31(a)(1) is being filed herewith. The review is requested because the Final Office Action contains clear error as described in the remarks that follow.

REMARKS

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected and remain pending. Claims 2-4, 6, 9, 13-16, 19, and 22-27 were canceled in previous responses. Claims 1, 5, 7, 8, 11, 12, 17, 18, 20, and 21 were previously amended. No claims are amended herein. Applicant respectfully requests consideration of the following remarks and allowance of the claims.

35 U.S.C. § 103 Rejection

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,718,551 (Swix) in view of U.S. Patent No. 5,822,018 (Farmer) in view of U.S. Patent No. 6,698,020 (Zigmond) in view of "NDS:NDS'XTV ™ time shifting technology empowers the viewer and the broadcaster," M2 Presswire, September 10, 1999, (XTV), and further in view of U.S. Patent No. 6,588,015 (Eyer). The rejection contains clear error because six claims are not addressed and because the cited art is mischaracterized in at least two respects.

The Final Office Action lists dependent claims 7, 8, 11, 17, 18, and 21 in the summary of the rejection (page 2, last ¶). However, no discussion of the individual limitations of these claims or explanation of the rejection with respect to these claims is provided. This issue was raised in Applicant's filings of May 18, 2010, and September 16, 2010, but no response was provided in either the Final Office Action or the Advisory Action. The rejection contains clear error because the limitations of these claims are not addressed.

In addition, the Final Office Action contains clear error because Farmer is mischaracterized in at least two respects.

Claim 1 recites, in part, *transferring the insertion point to the target viewer device over the second transport system.* The Final Office Action concedes that Swix "failed to teach the insertion point is transferred to the target device via the second transport system which uses less bandwidth" and asserts this limitation is found in Farmer (pg. 6, lines 3-5). However, this assertion represents clear error because Farmer teaches a single device which transfers cue tones and program material to two separate devices (Farmer, fig. 1). In Farmer, the target viewer devices are located in the area to the right of figure 1 entitled

"to cable distribution system and subscribers." Only a single transport system exists between Farmer CTV System 20 and those target viewer devices. Therefore, it is not possible for Farmer to teach *transferring the insertion point to the target viewer device over the second transport system* as asserted in the Final Office Action because Farmer does not have a second transport system linked to the target viewer devices.

The Advisory Action responds to this argument by stating "after the [Farmer] cue tones are transmitted to the Ad-Insertion System it is then transmitted to the single target device" (pg. 2, lines 7-8). This statement is also erroneous. Cue tones are transferred from Earth Station receiver 21 to Ad-Insertion System 24 (Farmer, fig. 1). The Ad-Insertion system receives the cue tones and generates other signals which are sent to other devices. However, there is no indication in the figures or text that the cue tones are relayed or further transmitted by the Ad-Insertion System to the target devices or to any other devices. The assertion in the Advisory Action is erroneous because there is no indication Farmer operates in this manner and the Advisory Action does not provide support for this assertion.

Second, the cue tones used in Farmer cannot be analogized to the claim 1 *insertion points* because the insertion points *comprise data indicating where in the selected video content the selected video advertising is to be inserted*. The Farmer cue tones are simply signals which instruct the Ad-Insertion system to perform a specific function at the immediate time (*see* Farmer, col. 4, lines 49-51). The cue tones do not contain information indicating positions within the selected video content. Only Earth Station Receiver 21 has information regarding the timing relationship between the cue tones and the particular locations within the video content (Farmer, fig. 1). Cue tones are simply electrical signal tones and do not themselves contain data indicating where advertising should be inserted in the selected video content. Because cue tones do not contain this type of data, it is erroneous to analogize them to *insertion points* which *comprise data indicating where in the selected video content the selected video advertising is to be inserted*.

The Advisory Action responds to this argument by stating that "Applicant's specification does not disclose that the insertion point is not a cue tone" and concludes that "an insertion point is interpreted to mean the same as the timing signals generated by

the cue tones" (pg. 2, lines 15-16, 19-20). However, it is illogical and erroneous to conclude that Applicant's *insertion points* are the same as cue tones because Applicant did not, in the specification, specifically state that they are not cue tones. Applicant's claim states that the insertion points comprise data and "claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention" (MPEP § 2172(I)).

The issues discussed above with respect to Farmer cannot be resolved through reference to Swix, Zigmond, XTV, or Eyer. The Notice of Panel Decision from Pre-Appeal Brief Review issued on 11/18/2009 indicates the application is allowable over Swix, Zigmond, XTV, and Eyer.

Therefore, for at least the reasons discussed above, Applicant contends that independent claim 1 is allowable in view of the combination of Swix, Farmer, Zigmond, XTV, and Eyer, and such indication is respectfully requested.

Independent claim 12 contains limitations similar to those discussed above with respect to claim 1, and is therefore allowable over the art of record for at least the same reasons as claim 1.

Claims 5, 7, 8, 10, 11, 17, 18, 20, and 21, while separately allowable over the art of record, depend from otherwise allowable independent claims 1 and 12. Applicant therefore refrains from further discussion of these dependent claims for the sake of brevity.

Therefore, in light of the discussion above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 and allowance of the claims.

CONCLUSION

Based on the remarks above, Applicant submits that the claims in their present form are allowable over the art of record. Additional reasons in support of patentability exist, but such reasons are omitted in the interests of clarity and brevity.

Applicant hereby authorizes the Office to charge Deposit Account No. 21-0765 the appropriate fee under 37 C.F.R. § 41.20(b)(1) for the Notice of Appeal filed herewith. Applicant believes no additional fees are due with respect to this filing. However, should the Office determine additional fees are necessary, the Office is authorized to charge Deposit Account No. 21-0765 accordingly.

Respectfully submitted,

/Todd C. Adelmann/

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